

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1, 4-16 and 19 are now pending in this application, claims 2-3, 17-18 and 20 having been cancelled by the present Amendment.

Claim Rejections- 35 U.S.C. §112, second paragraph

Claims 1-18 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. For the reasons set forth in detail below, this rejection is respectfully traversed.

More specifically, on pages 2 and 3, Items 3 and 5 of the Office Action, the Examiner asserts that the “specific structures” which perform the functions of the claimed “means for transmitting”, “means for storing” and “means for forming” are not described in the specification, and therefore the claims are indefinite under §112, second paragraph.

It is well established that under 35 U.S.C. §112, sixth paragraph, a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.” If means-plus function language is employed in a claim, the specification must set forth an adequate disclosure showing what is meant by that language. “If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as

required by the second paragraph of section 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (en banc).

However, the disclosure of the structure corresponding to the means-plus-function language does not have to be explicit. Instead, if one skilled in the art would be able to identify the structure, material or acts from the description in the specification for performing the recited function, then the requirements of 35 U.S.C. §112, second paragraph, are satisfied. See *In re Dossel*, 115 F.3d at 946-47, 42 USPQ2d at 1885.

Further, the disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

It is submitted that the structure corresponding to the “means for transmitting” is disclosed, e.g., on page 5, lines 6-11, which describe that “electronic mail is **transmitted** and received between a mail client 2 of a **transmitter** and a mail client 18 of a recipient. For example, the mail clients 2, 18 are an Internet facsimile machine, a personal computer or the like.”

It is submitted that the structure corresponding to the “means for storing a plurality of mail servers and a priority order of the mail servers” is disclosed, e.g., on page 1, line 26-page 2, line 2, which describes “The electronic mail client includes a **storage unit** which stores a plurality of mail servers and a priority ordering of the mail servers.” Further, it is submitted that one of ordinary skill in the art would recognize that an Internet facsimile machine, a personal

computer or the like, which are described as examples of the mail clients 2, 18, contain memory (means for storing) to store information and programs.

It is submitted that the structure corresponding to the “means for forming a transmission log” is disclosed, e.g., on page 8, lines 6-9, which describes “The *mail client* of the transmitter establishes a Transmission Control Protocol (TCP) connection to a normal SMTP server (mail server ranked first in the priority order), and *forms a log* of the TCP connection (step S1).”

In view of the above remarks, it is respectfully submitted that the structure corresponding to the “means-plus-function” language in the claims is described in a manner such that one skilled in the art would be able to identify the structure from the description in the specification for performing the recited function, thereby satisfying the requirements of 35 U.S.C. §112, second paragraph.

Claim Rejections – 35 U.S.C. §102

Claims 1-2, 17, 19 and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by **Katsuji** (Japanese Publication No. 11-164121). For the reasons set forth in detail below, this rejection, to the extent it is considered to apply to the amended claims, is respectfully traversed.

Initially, it is noted that claim 1 has been amended to more particularly define the operations taken when the selected mail server fails. The features recited in amended claim 1 are somewhat similar to those recited in original claim 3.

Katsuji discloses a facsimile machine 10 connected to an LAN that can execute e-mail transmission of image data read by the facsimile machine 10. More specifically, the LAN

includes two or more SMPT mail servers 20-60. Data scanned in by the facsimile machine 10 is converted to an e-mail, and a system controller 11 specifies an SMPT server 20 having highest priority via which to transmit the e-mail.

Further, the system control section 11 determines whether the SMPT server 20 having highest priority is available to be utilized as a mail server. If the SMPT server 20 having highest priority is available, then the e-mail transmission via the SMPT server 20 is carried out. If the SMPT server 20 stops due to failure or maintenance, the SMPT server to be used is switched to SMPT servers 30-60 one by one according to priority. The priority of the various SMPT servers 20-60 is stored in a table 17a in a memory 17. See, e.g., section [0017].

Accordingly, the transmission of image data read by the facsimile machine does not become impossible simply because of the failure of one mail server.

It is noted that the Examiner has applied the **Shimano et al.** reference against original claim 3 (see below). Because claim 1 now recites features similar to those recited in original claim 3, the **Shimano et al.** reference will now be discussed below. **Shimano et al.** is directed to a database driven robot programming system. The Examiner cites a portion of **Shimano et al.** teaching a part insertion routine, and, more particularly, to a routine that is performed when part insertion fails. As described in column 53, lines 4-42 of **Shimano et al.**, when a part insertion fails, a search routine is called that searches for an actual assembly location at a plurality of different locations and attempts insertion at the plurality of locations.

The Examiner relies particularly on column 53, lines 34-42, which state “If the insertion attempt is successful, the routine exits and returns parameters which indicate the location where

the part was inserted. Otherwise the search continues until all of the search locations have been tried. *If the search is not successful, the part insertion routine will generate an error message, thereby giving the operator the opportunity to instruct the system whether to retry the insertion, to abort the assembly, or to skip this step and move on to the next statement.*

First, it is submitted that the **Katsuji** reference does not disclose or suggest the claimed “determining means... .” **Katsuji** is related to selecting a mail server having a next priority order when a failure occurs. However, **Katsuji** does not disclose or suggest “determining a type of failure that has occurred” and “determining, in accordance with the type of failure determined, whether to select a mail server of next in priority order, to establish a connection again with the mail server that was selected at the time of the failure in the transmission of the electronic mail, or to cancel the transmission”

Further, it is submitted that **Shimano et al.** does not disclose or suggest the “determining means for determining a type of failure that has occurred when the transmission of the electronic mail via the selected mail server fails, and for determining whether to select a mail server of next in priority order, to establish a connection again with the mail server that was selected at the time of the failure in the transmission of the electronic mail, or to cancel the transmission, in accordance with the type of the failure,” as recited in claim 1.

Unlike the claimed invention, **Shimano et al.** relates to determining a failure in inserting a part, and is completely unrelated to determining a failure in transmission of an electronic mail. As such, **Shimano et al.** is completely unrelated to “determining means for...determining whether to select a mail server of next in priority order, to establish a connection again with the

mail server that was selected at the time of the failure in the transmission of the electronic mail, or to cancel the transmission, in accordance with the type of the failure.”

Further, as discussed above, **Shimano et al.** simply indicates that an error message is generated if the search for a successful insertion location fails. The *operator* must then determine the course of action to be taken after the error message is generated. *It is well established that a human being cannot constitute claimed structure* (see *In re Prater*, 415 F.2d 1393, 1398 (CCPA 1969)). Therefore, contrary to the assertion in the Office Action, an operator instructing a part insertion system whether to retry the insertion, to abort the assembly, or to skip this step and move on to the next statement does not correspond to the claimed “determining means”.

Therefore, it is respectfully submitted that neither **Katsuji** nor **Shimano et al.** disclose or suggest the features recited in claim 1 and claims 4-16 which depend therefrom. Claim 19 recites the invention in a manner similar to claim 1 and is allowable for the same reasons articulated above regarding claim 1. Reconsideration and withdrawal of the rejection under §102 are respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Katsuji** (Japanese Publication No. 11-164121). Claims 3-5, 12 and 18 are rejected under 35 U.S.C. §103(a) as being anticipated by **Katsuji** (Japanese Publication No. 11-164121) in view of **Shimano et al.** (USP 4,835,730). Claims 6-8 are rejected under 35 U.S.C. §103(a) as being

unpatentable over **Katsuji** (Japanese Publication No. 11-164121) in view of **Shimano et al.** (USP 4,835,730) and further in view of **Postal** ("RFC 821: Simple Mail Transfer Protocol"). Claims 9-11 are rejected under 35 U.S.C. §103(a) as being **Katsuji** (Japanese Publication No. 11-164121) in view of **Glasser et al.** (USP 5,956,715). Claims 14-16 are rejected under 35 U.S.C. §103(a) **Katsuji** (Japanese Publication No. 11-164121) in view of **Witek** (USP 5,461,488).

It is submitted that each of pending claims 4-16 depend either directly or indirectly from the claims amended as discussed above, and are allowable for the same reasons discussed above with respect to independent claim 1.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

Application No. 10/632,863
Art Unit: 2142

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 030817

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, with the first name "William" and last name "Schertler" clearly distinguishable.

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